

Attorney Docket No. 2002\_0426A  
Serial No. 10/089,040  
June 8, 2006

### REMARKS

#### **I. EXAMINER INTERVIEW, CLAIM STATUS & AMENDMENTS**

Applicants thank Examiner Moore for the telephone interview on May 5, 2006, during which the outstanding rejection was discussed.

Claims 1, 3, 6-10, 12 and 13 were pending in this application when last examined and stand rejected.

Claims 1, 10, 12 and 13 have been amended to clarify the structural relationship of the probes along the lines suggested by the Examiner at the bottom of page 3 of the Action and as discussed during the interview. These claims have also been amended to replace "N-terminal half" and "C-terminal half" with "N-terminus" or "N-terminal portion" and "C-terminus" or "C-terminal portion", respectively, throughout the claims. Support for these changes can be found in the disclosure, for example, at page 5, lines 6-9 (of the substitute specification) and the probes in Fig. 4.

Claims 1 and 12 have also been amended to incorporate the subject matter of claims 7 and 8.

Claim 9 has been amended to depend on claim 1 rather than claim 8 (which was cancelled). Support can be found in the claims as filed.

Therefore, no new matter has been added by this amendment to the claims.

Claims 6-8 have been cancelled without prejudice or disclaimer thereto. Applicants reserve the right to file a continuation or divisional application on any cancelled subject matter.

Claims 1, 3, 9-10, 12 and 13 are pending upon entry of this amendment.

#### **II. CLAIM OBJECTIONS**

On page 2 of the Action, claims 1, 10, 12 and 13 were objected to for reciting "half" on the basis that the term is misleading. It was indicated that this term does not appear in the specification and no division by halves is conceptually disclosed.

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Claim 12 was also objected to for lacking an appropriate use of the definite article "the" in the description at lines 8, 11 and 12 of the claim.

It is respectfully submitted that the present amendment overcomes these objections.

The claims have been amended to replace "N-half" and "C-half" with "N-terminal portion of" and "C-terminal portion of" or "N-terminus" and "C-terminus" along the lines suggested by the Examiner at the bottom of page 3 of the Action. Support can be found at page 5, lines 6-9 of the substitute specification and Fig. 4.

Therefore, the claim objections are untenable and should be withdrawn.

### III. INDEFINITENESS REJECTIONS

In items 3-4 of the Action, claims 1, 3, 6-10 and 13 were rejected under 35 U.S.C. § 112, second paragraph, as indefinite for the terms "N-half", "C-half", "connected to" and "for connecting". It was indicated that the claims should be also amended to further clarify the structural relationship of the probes to require "fusion" between the probes and their respective target proteins.

Claim 10 was independently rejected under 35 U.S.C. § 112, second paragraph, for the terms "connecting" and "system."

Claim 13 was also independently rejected under 35 U.S.C. § 112, second paragraph, on the basis that: (1) the claim lacks antecedent basis at line 6 for "the eukaryotic cell"; and (2) the claim is incomplete, because it fails to clearly set forth the structural relationship of the probes required for "fusion" between the probes and their respective target proteins.

These rejections are respectfully traversed as applied to the amended claims.

The claims have been amended along lines discussed above and during the telephone interview. In particular, claims 1, 10, 12 and 13 have been amended to clarify the structural relationship of the probes along suggested by the Examiner at the bottom of page 3 of the Action and as discussed during the interview. The terms "N-terminal half" and "C-terminal half" were replaced with "N-terminus" and "C-terminus" or "N-terminal portion of" and "C-terminal portion of",

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respectively, throughout the claims. Again, this construct is supported by the disclosure at page 5, lines 6-9 of the substitute specification and Fig. 4.

Claim 10 has also been amended to clarify the structural relationship of the probes required for "fusion" between the probes and their respective target proteins. The term "connecting" in claim 10 has been replaced with the more accurate term of "fusing." Claim 10 was also amended to define the conditions for the "system."

Regarding the lack of antecedent basis concern in claim 13, please note that line 5 of the claim recites "a eukaryotic cell", which provides the proper antecedent basis for "the eukaryotic cell" in line 6. Claim 13 has also been amended to clarify the structural relationship of the probes required for "fusion" between the probes and their respective target proteins.

Therefore, the rejections of claims 1, 3, 6-10 and 13 under 35 U.S.C. § 112, second paragraph, are untenable and should be withdrawn.

#### **IV. OBVIOUSNESS REJECTION**

In item 4 on pages 4-8 of the Action, claims 1, 6, 10, 12 and 13 were rejected under 35 U.S.C. § 103(a) as obvious over Remy et al. (1999) and Wu et al. (1998a) in view of Wu et al. (1998b).

It is respectfully submitted that the present amendment overcomes this rejection.

The claims have been amended to incorporate the subject matter of claims 7 and 8, which were not included in this rejection. During the interview, the Examiner noted that claim 7, which is directed to a green fluorescent protein, was not included in this rejection given difficulty in using a green fluorescent protein as in the present invention. The Examiner also noted that claim 8 was not included in this rejection as it is directed to a luminescent enzyme as the indicator protein. The Examiner noted that the cited prior art references only disclose certain fluorescent proteins (but not a green fluorescent protein) and not luminescent enzymes.

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Therefore, the obviousness rejection of claims 1, 6, 10, 12 and 13 under 35 U.S.C. § 103(a) over Remy et al. (1999) and Wu et al. (1998a) in view of Wu et al. (1998b) is untenable and should be withdrawn.

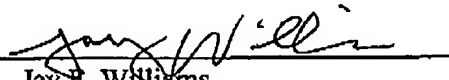
### CONCLUSION

In view of the foregoing amendments and remarks, it is respectfully submitted that the present application is in condition for allowance and early notice to that effect is hereby requested.

If the Examiner has any comments or proposals for expediting prosecution, please contact the undersigned attorney at the telephone number below.

Respectfully submitted,

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